REMARKS

Reconsideration of the present application is respectfully requested.

Claims 2-4, 9 and 12 are in the application. Claim 2 is directed to a perforating gun which has in intumescent coating applied to a portion of its structure. Claims 3, 4, 9 and 12 depend from claim 2.

In the Office Action, the Examiner asserted that it would have been obvious to provide a perforating gun with an intumescent coating based on U.S. Patent No. 6, 336,408 to Parrott ("Parrott patent") in view of U.S. Patent 3,780,891 to Riccitiello. Applicants respectfully disagree.

A. Standards With Respect to Establishing a *Prima Facie* Case of Obviousness

Three criteria must be established in order to make out a *prima facie* case of obviousness based on a combination of prior art references. First, there must be some suggestion or motivation, either in the references used by the Examiner or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when combined, must teach or suggest all of the claimed limitations. *See* M.P.E.P. § 2143; *see also In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

Before the conclusion of obviousness of a patent claim can be made based on a combination of references, there must have been a suggestion or motivation to lead an inventor to combine those references. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984); *see also Viskase Corp. v. Am. Nat'l Can Co.*, 261 F.3d 1316,

1327 (Fed. Cir. 2001) (judgment upholding validity of patents in suit affirmed in absence of suggestion, motivation or teaching to combined the prior art); *Jazz Photo Corp. v. U.S. Int'l Trade Comm'n,* 264 F.3d 1094, 1109 (Fed. Cir. 2001) (In absence of a suggestion to combine prior art references, the patented process was not rendered obvious); *Karsten Mfg. Corp. v. Cleveland Golf Co.,* 242 F.3d 1376, 1385 (Fed. Cir. 2001); *WMS Gaming, Inc. v. Int'l Game Technology,* 184 F.3d 1339, 1359 (Fed. Cir. 1999); *In re Dance,* 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon,* 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. *Vaeck,* 947 F.2d at 493.

A critical step in analyzing the patentability of claims pursuant to section 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Dembiczak,* 175 F.3d 994, 999 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of the hindsight syndrome wherein that which only the invention taught is used against its teacher." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.,* 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert denied,* 469 US 851 (1984).

B. No *Prima Facie* Case Has Been Established

The combination of the Parrott and Riccitiello patents simply does not establish a *prima facie* case of obviousness of claim 2, because no suggestion exists in the references to make the combination that the Examiner has made.

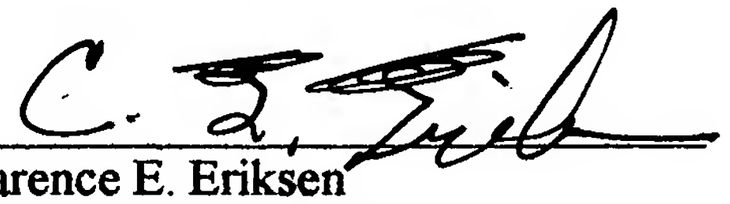
Moreover, it is apparent from the foregoing that what the Examiner did in arriving at the conclusion of obviousness is to use applicant's invention as a template in attempting to piece applicant's invention together from the prior art without any suggestion in the prior art to do so. Such a procedure is the essence of hindsight reconstruction, *Dembiczak*, 175 F.3d at 999, and is improper as a matter of law. *Texas Instruments Inc. v. U.S. Int'l Trade Comm'n*, 998 F2.d 1165 (Fed. Cir. 1993).

Further, the law is well-established that dependent claims are patentable if the independent claim from which they depend are patentable. *E.g. In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988). Thus, the demonstrated patentability of independent claim 2 over the Parrott and Riccitiello references cited by the Examiner establishes the patentability of dependent claims 3, 4, 9 and 12 over those references as a matter of law.

C. Conclusion

The present application is in a condition for allowance, and such action is requested. If the Examiner is of the view that any matter exists that would somehow preclude allowance, the Examiner is requested to telephone the undersigned to resolve such matter.

Respectfully submitted,



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